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Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-51 are pending in the application, with claims 1, 44, and 51 being the independent claims. Support for the amendment to claim 1 can be found, *inter alia*, at page 11, paragraph [0040], lines 1-2. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Objection to the Abstract

The Examiner objected to the abstract of the disclosure because the Examiner is of the opinion that the term "comprises," appearing on page 39, line 2, is legal phraseology (Office Action, page 2). Applicants have amended the abstract to replace the word "comprises" with the word "includes." Applicants respectfully submit that the objection to the abstract of the disclosure has been overcome by amendment and should be withdrawn.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1, 8-9 and 17-43 under 35 U.S.C. § 103(a) as being unpatentable over Hemphill *et al.* (U.S. Patent No. 6,197,184) in view of Evans, II *et al.* (U.S. Patent No. 5,124,022) (Office Action, page 3). Applicants respectfully traverse this rejection.

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The Examiner is of the opinion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the step of anodizing the foil disclosed in Evans, II *et al.* with the method of Hemphill *et al.* in order to increase the capacitance of the anodic foil (Office Action, page 3). Applicants respectfully disagree.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2143. Applicants respectfully submit that the Examiner has not established a motivation to combine Hemphill *et al.* and Evans, II *et al.*.

Hemphill *et al.* discloses a method of producing an anodic foil for use in a capacitor comprising the steps of hydrating the foil and forming a barrier oxide layer on the foil (col. 12, lines 29-39). Hemphill *et al.* does not teach or suggest the step of anodizing the foil as claimed in the present invention.

Evans, II *et al.* discloses a process of anodizing a foil in an aqueous phosphorus-containing organic electrolyte to produce a non-porous, barrier oxide layer that is *resistant to hydration* (col. 2, lines 23-30, and col. 6, lines 19-20). Evans, II *et al.* does not teach or suggest a hydration step or provide motivation or suggestion for the combination of a hydration step with the anodizing step to increase the capacitance of the anodic foil. In fact, the focus on hydration resistance in Evans, II *et al.* teaches away from the use of a hydration step. Thus, Applicants respectfully submit that the Examiner has not established a motivation to

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combine Hemphill *et al.* and Evans, II *et al.* as required to establish a *prima facie* case of obviousness.

In addition, for the purpose of advancing the prosecution of this application, Applicants have amended claim 1 to specify that the step of anodizing the foil is performed prior to the step of hydrating the foil. Neither Hemphill *et al.* nor Evans, II *et al.* teach or suggest anodizing the foil prior to hydrating the foil. Therefore, the combination of Hemphill *et al.* and Evans, II *et al.* does not teach each and every limitation of amended claim 1.

Further, Evans, II *et al.* teaches away from amended claim 1 by disclosing that the step of anodizing forms a hydration resistant composite layer on the anodic foil (col. 2, lines 23-30). Because the composite layer resulting from the anodizing step in Evans, II *et al.* is resistant to hydration, one of ordinary skill in the art would be discouraged from hydrating the foil after the anodizing step. Thus, one of ordinary skill in the art would not be motivated to combine the teachings of Hemphill *et al.* and Evans, II *et al.* to obtain the method of amended claim 1. Therefore, Applicants respectfully submit that amended claim 1 is patentable and respectfully request that the rejection under 35 U.S.C. § 103(a) over Hemphill *et al.* in view of Evans, II *et al.* be withdrawn.

Claims 8-9 and 17-43 depend either directly or indirectly from claim 1 and are patentable over the cited art for at least the above-stated reasons. Therefore, applicants respectfully submit that the rejection of claims 8-9 and 17-43 under 35 U.S.C. § 103(a) over Hemphill *et al.* in view of Evans, II *et al.* has been overcome and should be withdrawn.

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Allowable Subject Matter

The Examiner indicated that claims 2-7 and 10-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form (Office Action, page 6). Claims 2-7 and 10-16 depend either directly or indirectly from claim 1. For at least the reasons stated above, Applicants respectfully submit that the rejection of claim 1 has been overcome and therefore, claims 2-7 and 10-16 should be in condition for allowance without further amendment.

Claims 44-51 have been allowed.


Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant, therefore, respectfully submits that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Steven M. Mitchell at (408) 522-6101.

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Pursuant to 37 C.F.R. 1.136(a)(3), Applicant hereby requests and authorizes the U.S. Patent and Trademark Office to (1) treat any concurrent or future reply that requires a petition for extension of time as incorporating a petition for extension of time for the appropriate length of time and (2) charge all required fees, including extension of time fees and fees under 37 C.F.R. 1.16 and 1.17, to Deposit Account No. 22-0265.

Respectfully submitted,

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